

Appl. No. 09/721,728

Reply dated September 27, 2006

Reply to Final Office Action mailed March 30, 2006

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REMARKS

Applicant has amended the abstract to overcome the examiner's objection and the objection should be withdrawn.

Applicant has amended the claims of the application to clarify the invention.

PRIOR ART REJECTIONS

In response to the Examiner's rejection of Claims 1-41 under 35 U.S.C. 103 as being obvious over US Patent No. 5,832,460 to Bednar in view of US Patent No. 5,590,197 to Chen, Applicant traverses the rejection. In particular, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. *M.P.E.P.* § 2143. The examiner has not established a *prima facie* case of obviousness because 1) prior art references do not teach/suggest all of the claim limitations; and 2) the examiner has not specifically pointed to any motivation/suggestion to combine the references either in the references or in the knowledge generally available to one of ordinary skill in the art.

Prior Art Reference Do Not Teach/Suggest all of the Claim Limitations

The prior art cited by the examiner does not teach/suggest each limitation of the claims. For example, neither Bednar nor Chen discloses or suggests "communicating the payment instructions directly to the payee to initiate payment of the amount" as set forth in claims 1, 2, 21 and 22. Bednar discloses that a electronic bill presenter 200 is used to facilitate the payment of electronic bills for a user. Bednar does not disclose communicating the payment instructions directly to the payor to initiate payment of the amount. Chen also does not disclose this feature of the independent claims. Therefore, the examiner has not established a *prima facie* case of obviousness for the independent claims and the rejection should be

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withdrawn. The rejection of the dependent claims as being obvious is also improper and should be withdrawn.

No Motivation/Suggestion to Combine the References

The Examiner has failed to point to any suggestion or motivation in the prior art to combine Bednar with Chen. It is well-settled that "a showing of a suggestion, teaching, or motivation to combine [or modify] the prior art references is an 'essential component of an obviousness holding'." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). In the initial rejection (repeated in the final office action), the examiner has asserted that "It would be obvious ... to incorporate the ... structured remittance data ... as taught by Chen into the method and means disclosed by Bednar, in order to protect personal and payment information from getting into the hands of would-be thieves." See *December 17, 2003 Office action at page 5*. The examiner has not shown the suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references. In addition, the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the combination. *In re Fritch*, 972 F.2d 1260, 1266 n. 14, 23 USPQ2d 1780, 1783-4 n.14 (Fed Cir. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The examiner has not pointed to any place in the prior art in which the desirability of the combination of the prior art references is suggested. Therefore, the examiner has failed to establish a prima facie case of obviousness for at least this reason.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-19 and 21-39 and 41 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

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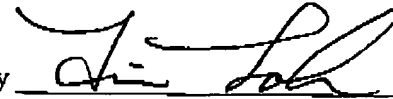
The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

DLA PIPER RUDNICK GRAY CARY US LLP

Dated: 9-27-2006

By



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